



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,963	02/01/2002	Martin Steinwender	20496-321	8756

21890 7590 04/09/2003

PROSKAUER ROSE LLP  
PATENT DEPARTMENT  
1585 BROADWAY  
NEW YORK, NY 10036

EXAMINER
----------

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
----------	--------------

3673

DATE MAILED: 04/09/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/061,963

Applicant(s)

STEINWENDER, MARTIN

Examiner

M. Safavi

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 25-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

Art Unit: 3673

***Specification***

1. The disclosure is objected to because of the following informalities: Pages 4 and 10 make reference to claims in particular and in general.

Appropriate correction is required.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “components of furniture” as well as “furniture part” and “fastener” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 7-10, 12, 13, 19, 20, 22, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3673

Claim 3, as at line 3, recites “..effect of external energy” then proceeds, as at lines 3-5, to recite “particularly thermal energy, ultrasound energy, high frequency energy, light energy, or UV energy”. Does the language of lines 3-5 of claim 3 serve to further limit the type of “external energy” defined by claim 3? Is the recitation of lines 3-5 of claim 3 attempting to list an alternative? Further, any Markush grouping presented within the claim language shall define a definite genus to which the invention is directed.

Claim 7 recites “the reaction adhesive” which does not appear to possess an antecedent basis within the claim language. In any case, are the “at least two components”, or any of the components, the same as “a material” introduced at line 8 of claim 1? Otherwise, what would be the relationship between the “at least two components”, or any component, and “a material”? Are they one and the same?

Claim 8 recites “the reaction adhesive” which does not appear to possess an antecedent basis within the claim language. In any case, are the “at least two components”, or any of the components, the same as “a material” introduced at line 8 of claim 1? Are the “at least two components”, or any of the components, the same as the “one material” or “a second material” recited at lines 3 and 5 of claim 8? Otherwise, what would be the relationship between the “at least two components”, or any component, and “a material” or “one material” or “a second material”? Are they one and the same?

Art Unit: 3673

Claim 12, to what, specifically, does “different matrix layers” refer? Do “different matrix layers” form part of the claimed invention? Or, is claim 12 merely reciting an adhesive with no particular relationship to the invention defined by claim 1 and 11?

Claim 13, to what, specifically, does “different layers of capsules” refer? Do “different layers of capsules” form part of the claimed invention? Or, is claim 13 merely reciting an adhesive with no particular relationship to the invention defined by claim 1 and 11? Further, it is not clear as to what “components” refers or to what “materials” refers with claim 12 reciting “materials” and claim 13 reciting “components”. Here, again, what would be the relationship between “components”, or any component, and “materials” or any recited material? Are they one and the same?

Claim 15, line 2, to which joint face does “the joint face” refer?

Claim 19, as at lines 2-3, recites “made of a lignocellulose-containing material” then proceeds, as at line 3, to recite “preferable of wood or a wooden material”. Does the language of line 3 of claim 19 serve to further limit the type of “lignocellulose-containing material” defined by claim 19? Is the recitation of line 3 of claim 19 attempting to list an alternative? Further, any Markush grouping presented within the claim language shall define a definite genus to which the invention is directed.

Claim 20, “the non-cellulose-containing component” lacks an antecedent basis within the claim.

Art Unit: 3673

Claim 22, as at lines 2-3, recites “the other component is a fastener” then proceeds, as at line 3, to recite “particularly a dowel, screw, or hinge”. Does the language of line 3 of claim 22 serve to further limit the type of “fastener” defined by claim 22? Is the recitation of line 3 of claim 22 attempting to list an alternative? Further, any Markush grouping presented within the claim language shall define a definite genus to which the invention is directed.

Claim 24, lines 3-4, “the joint faces” lacks an antecedent basis within the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-17, 21, 22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Roesch et al. Roesch et al. discloses, Figs. 1-3, a joint between two components utilizing a multi-component adhesive which adhesive can take the form of a matrix 5 and microcapsules 1, Fig. 1,

Art Unit: 3673

as well as layers of matrix 5 and microcapsules 1, Fig. 2, as well as application of two different types of microcapsules possessing different materials of the reaction adhesive system.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ihle et al. in view of Roesch et al.

Ihle et al. discloses, col. 1, lines 6-12, a joint between two components utilizing a multi-component adhesive which adhesive including fasteners and furniture components, (i.e. floor wall and ceiling construction), col. 2, lines 4-9.

Roesch et al. discloses, Figs. 1-3, a joint between two components utilizing a multi-component adhesive which adhesive can take the form of a matrix 5 and microcapsules 1, Fig. 1, as well as layers of matrix 5 and microcapsules 1, Fig. 2, as well as application of two different types of microcapsules possessing different materials of the reaction adhesive system.

To have applied any of the multi-component adhesive systems disclosed in Roesch et al. within the connection of Ihle et al., thus taking advantage of any of various well known multi-

Art Unit: 3673

component adhesives, would have constituted an obvious expedient to one having ordinary skill in the art at the time the invention was made.

9. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Nemeth or German reference 297,03,963 in view of Roesch et al.

Nemeth discloses, Fig. 9, utilization of adhesive within a joint between two components of a floor covering. German reference '963 discloses, Figs. 1 and 2, utilization of adhesive within a joint between two components of a floor covering.

Roesch et al. discloses, Figs. 1-3, a joint between two components utilizing a multi-component adhesive which adhesive can take the form of a matrix 5 and microcapsules 1, Fig. 1, as well as layers of matrix 5 and microcapsules 1, Fig. 2, as well as application of two different types of microcapsules possessing different materials of the reaction adhesive system.

To have applied any of the multi-component adhesive systems disclosed in Roesch et al. within the floor covering connections of either of Nemeth or German reference '963, thus taking advantage of any of various well known multi-component adhesives, would have constituted an obvious expedient to one having ordinary skill in the art at the time the invention was made.



Art Unit: 3673

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



**MICHAEL SAFAVI**  
**PRIMARY EXAMINER**  
**ART UNIT 354**

M. Safavi  
April 7, 2003